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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,975	01/05/2001	Leonid Raiz	12116-002001	4739

26161 7590 11/30/2005

FISH & RICHARDSON PC  
P.O. BOX 1022  
MINNEAPOLIS, MN 55440-1022

EXAMINER

SONG, HOSUK

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/755,975

Applicant(s)

RAIZ ET AL.

Examiner

Hosuk Song

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-2,4-7,11,13,16,18,20,23-24,27,30 remain rejected under 35 U.S.C. 102(e) as being anticipated by Clark(US 6,343,280).

Claim 1: Clark disclose distributing authorization keys from a subscription server to computers on which copies of an application program are stored and are to be run in (fig.1 and col.15,lines 19-27). Clark discloses each of the authorization keys being associated with a validity period during which the authorization key will be valid and each authorization key allowing an application program to be operated during the validity in (col.21,lines 21-28). Clark disclose at intermittent times that may be as infrequent as the times when the validity period ends,distributing new authorization keys to each of the computers in (col.21,lines 45-53 and col.26,lines 16-19). Clark discloses the keys being distributed electronically in a manner that is transparent to users of the computers in (fig.1).

Claim 2: Clark discloses new authorization keys are distributed in exchange for money in (col.17,lines 15-19;col.21,lines 25-26).

Claim 4: Clark discloses authorization key carries information about the validity period in (col.21,lines 17-27).

Claim 5: Clark disclose new authorization keys are distributed by communication between the subscription server and each of the computers using a standard communication protocol on a publicly accessible communication network in (col.13,lines 4-8).

Claim 6: Clark discloses validity period comprises a normal calendar period in (col.21,lines 45-48).

Claim 7: Clark discloses validity period comprises a month in (col.21,lines 45-47).

Claim 11: Clark discloses authorization key carries information about features of the application program that is enabled by the key in (col.21,lines 17-26).

Claim 13: Clark discloses application program is distributed on a portable medium type or by a software download via the Internet in (col.13,lines 5-8).

Claim 16: Clark discloses authorization keys are distributed in response to instructions given by a user interactively using a standard TCP/IP communication to the subscription server in (col.26,lines 5-19).

Claim 18: Clark disclose application program may be used for a period as long as the validity period as long as the validity period while the computer on which it is running out of communication with the subscription server in (col.21,lines 45-53).

Claim 19: Clark disclose users of the copies of the application programs are grouped within enterprises and the enterprise interacts with the subscription server to manage the number and duration of authorization keys that are distributed to its users and the payment for the authorization keys in (fig.1 and col.21,lines 17-28).

Claim 20: Clark discloses authorization keys are stored on the user computers in (fig.1,#2).

Claim 23: Clark discloses user self-subscribes to the use of the application program without help of another person in (col.15,lines 39-46).

Claim 24: Clark discloses subscription server comprises an Internet server using a standard TCP/IP protocol in (col.13,lines 1-8).

Claim 27: Clark discloses at least one of the modes requires an authorization key in (col.21,lines 50-53).

Claim 29: Clark discloses one of the modes comprises a subscription mode in (col.21,lines 45-48).

Claim 30: Clark discloses one of the modes comprises full use of the application program and the authorization key is distributed in exchange for a payment in (col.21,lines 49-51).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3,17,22,25-26,28,31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark(US 6,343,280).

Claims 25,26,31: Clark does not specifically disclose application program may be run in at least two different modes of use. Official notice is taken that application program run in at least two different modes of use is well known in the art. One of ordinary skill in the art would have been motivated to employ application to run in at least two different modes of use in order for user to try the program first(trial version) before full purchase(full version) thus offering user preview of the software before making full financial commitment.

Claims 3,17: Clark does not specifically disclose new authorization key is distributed automatically when an existing authorization key has reached the end of its validity period. Official notice

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is taken that distribution of new authorization key when an existing authorization key has reached the end of its validity period is well known in the art. One of ordinary skill in the art would have been motivated to employ automatic key distribution in order to continuously provide service to the subscriber without service interruption thus providing convenient and user friendly environment to the subscriber.

Claim 22: Clark does not specifically disclose authorization key is encrypted. Official notice is taken that encrypting authorization key is well known in the art. One of ordinary skill in the art would have been motivated to encrypt authorization key because it adds another layer of protection against key hackers trying to defeat the system.

Claim 28: Clark does not specifically disclose demonstration mode in which some features of the application program are disabled. Official notice is taken that demonstration mode is well known in the art. One of ordinary skill in the art would have been motivated to employ demonstration mode in order to attract customer to purchase full version of software.

3. Claims 10,12,14,15,21,32,43,33-40,42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark(US 6,343,280) in view of Wilde et al.(US 6,446,260).

Claims 10,12,14,15,21: Clark does not specifically disclose authorization key carries information about the identity of a computer on which use of the application computer is authorized. Wilde discloses this limitation in (Col.11,lines 11-31). It would have been obvious to person of ordinary skill in the art at the time invention was made to employ a key carries information about the identity of a computer on which use of the application computer is authorized as taught in Wilde with system of Clark in order to deter hacker from using a program using a stolen key. Stolen key is useless unless it is employed in specific device according to key information thus enhancing security of its system.

Claims 32,43: Clark discloses distributing without charge,copies of an application program online or on storage media for installation on one or more computers in (col.13,lines 5-8). Clark disclose enabling a user of one of he computers to choose among modes in which he wishes to run the application

program in (col.21,lines 40-50). Clark disclose in at least one of the chosen modes,enabling the user to run the application program without requiring the user to provide information about the user in (col.21,lines 46-47). Clark does not specifically disclose authorization key carries information about the identity of a computer on which use of the application computer is authorized. Wilde discloses this limitation in (Col.11,lines 11-31). It would have been obvious to person of ordinary skill in the art at the time invention was made to employ a key carries information about the identity of a computer on which use of the application computer is authorized as taught in Wilde with system of Clark in order to deter hacker from using a program using a stolen key. Stolen key is useless unless it is employed in specific device according to key information thus enhancing security of its system. Clark disclose authorization key having a limited validity period in (col.21,lines 51-53).

Claim 33: Clark does not specifically disclose demonstration mode in which some features of the application program are disabled. Official notice is taken that demonstration mode is well known in the art. One of ordinary skill in the art would have been motivated to employ demonstration mode in order to attract customer to purchase full version of software.

Claim 34: Clark discloses trial mode comprises a trial mode that requires information but no payment in (col.21,lines 46-47).

Claims 35-37: Clark one mode comprises a subscription mode that requires information and payment in (col.21,lines 46-50).

Claims 38: Clark discloses application program is distributed on a portable medium or by a software download through the Internet in (col.13,lines 5-8).

Claim 39: Clark discloses authorization keys are distributed in response to instructions given by a user interactively using a standard TCP/IP communication to the subscription server in (col.26,lines 5-19).

Claim 40: Clark disclose application program may be used for a period as long as the validity period as long as the validity period while the computer on which it is running out of communication with the subscription server in (col.21,lines 45-53).

Claim 41: Clark disclose users of the copies of the application programs are grouped within enterprises and the enterprise interacts with the subscription server to manage the number and duration of authorization keys that are distributed to its users and the payment for the authorization keys in (fig.1 and col.21,lines 17-28).

Claim 42: Clark discloses authorization keys are stored on the user computers in (fig.1,#2).

4. Claims 8,9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark(US 6,343,280) in view of Brandt et al.(US 5,758,068).

Claims 8-9: Clark does not specifically disclose when a validity period lapses, automatically providing a grace period based on information contained in the authorization key, the grace period permitting continued running of the application program. Brandt's patent discloses this limitation in (col.2,lines 16-19;col.3,lines 26-28). It would have been obvious to person of ordinary skill in the art at the time invention was made to provide grace period when a validity period lapses as taught in Brandt with system disclosed in Clark in order to continuously provide service to the subscriber without service interruption thus providing convenient and user friendly environment to the subscriber.

#### ***Response to Arguments***

5. Applicant's arguments filed 9/22/05 have been fully considered but they are not persuasive. Applicant has argued that there is no application program stored on or to be run on the user's computer in Clark patent. In response: Examiner disagrees. According to amended claim 1, authorization keys are distributed from a subscription server to *computers* on which copies of an application program are stored and are to be run. Applicant does not specifically claim where application program are stored and are to be run on the "users computer". Applicant has argued that the modified software of Clark patent only



works when the user contacts the license server, and the other components are run from the license server. In response: the modified software of Clark is an executable code residing on the user's computer(see col.14,59-60). Even if modified software is controlled by the license server, the modified software is stored and run on the user's computer. Further, user key, copy of the trap software and a copy of the modified software are transmitted/installed on the user computer in order for user to execute/run modified software(see col.15,lines 19-27). In response to applicant's arguments on claims 3,17,22,25,26,28 and 31, Examiner has provided sufficient motivation in support of Official notice. Applicant has argued that there would be no motivation to provide such a key with Clark because Clark purports to provide security by splitting the program up into portions at the user's computer and at the license server and thus there would be no reason for skilled artisan to seek to use a key such as that recited in the pending claims. In response: Examiner disagrees because splitting the program up into portion still requires a key to execute the program. By carrying information about the ID of a computer in the authorization key, it enhances security of its system because even if all parts of the program including the key are hijacked by the intruder, key and program can not be executed due to the fact that it is a device specific key meaning it cannot be run on any other unauthorized device. Therefore it adds extra layer of security in Clark's system. Applicant has argued that certain other dependent claims discuss the operation of the application program in various modes(claims 33-37) to select or use a particular mode of operation. Examiner disagrees. Clark discloses various modes in (col.21,lines 45-50). Applicant has argued that there would be no motivation to provide such "grace" feature because the user in the Clark patent must be attached permanently to the license server to make the program operate at all. Examiner disagree.Clark disclose "key expiration"(col.21,lines 22-28,50-53) in which the key controls the running the software and not whether license server is permanently attached to the user computer. Brandt patent was provided as a secondary reference to meet "grace period" limitation and sufficient motivation was provided in combining Clark with Brandt to make the rejection.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***USPTO Contact Information***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hosuk Song whose telephone number is 571-272-3857. The examiner can normally be reached on Tue-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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HS

A handwritten signature in black ink, appearing to read 'H. S.' followed by a stylized flourish.

Hosuk Song  
Primary Examiner  
Art Unit 2135